

### **REMARKS**

The present Amendment is responsive to the Official Action dated December 31, 2007, and is filed in conjunction with a terminal disclaimer and an information disclosure statement (IDS). The Official Action rejected all of the claims pending in the application under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,317,784 to Mackintosh *et al.* (“*Mackintosh*”) in view of U.S. Patent No. 6,795,711 to Timo Sivula (“*Sivula*”). Applicant notes that while the Official Action does not list Claim 31 in the statement of rejection (*see* p. 5 of the Official Action), the rejection of that claim based on *Sivula* is discussed (*see* p. 8 of the Official Action), and Applicant assumes that such rejection is intended. Several claims were also rejected on the grounds of non-statutory double patenting.

By this Amendment, Claims 1, 16, 19, 22-24, 26, 27, 31-38, 41-43, and 46-50 have been amended. Reconsideration of all of the pending claims in view of the preceding amendments and the following remarks is respectfully requested.

#### **I. Rejections Under Section 103**

Amended independent Claim 1 of the present application reads as follows:

1. A system for enhancing communication on a wireless network using predefined messages, comprising:

a service platform running an on-line service, the on-line service for providing a certain content, the service platform comprising;

transmitting means for transmitting the certain content to a user of at least one wireless terminal; and

providing means for providing along with the transmitted certain content at least one content-related predefined message to the user of the at least one wireless terminal based upon the certain content, the message being generated independently of the certain content and automatically modified based on an identity of the certain content;

at least one wireless terminal at least for receiving the certain content and the at least one content-related predefined message from the on-line service of said service platform through the wireless network, the at least one wireless terminal comprising:

selecting means for enabling selecting, by the user of said at least one wireless terminal, whether to originally transmit one or more of the provided at least one content-related predefined message wirelessly from said at least one wireless terminal; and

transmitting means for originally transmitting, if the user of said at least one wireless terminal selects to transmit one or more of the provided

at least one content-related predefined message, the selected one or more of the provided at least one content-related predefined message to at least one address selectable by the user of said at least one wireless terminal.

An example of an embodiment that operates consistently with Claim 1 is where a user may be using her cellular telephone to listen to a music station and a predefined message related to the content (*i.e.*, the received music) is presented to the user. The predefined message could be, for example, "Hey, check out what's on music station Z" or "Check out the new Britney Spears song on music station Z." The user can either send the provided content-related predefined message or not.

Each of independent Claims 11, 31, 43, and 46 also recites "selecting, by the user of said at least one wireless terminal, whether to originally transmit one or more of the provided at least one content-related predefined message . . . from said at least one wireless terminal" and "originally transmitting . . . the selected one or more of the provided . . . content-related predefined message to at least one address selectable by the user of said at least one wireless terminal," albeit in slightly different form. All of the independent claims were rejected as obvious in light of the combination of *Mackintosh* and *Sivula*.

As an initial matter, Applicant notes that *Sivula* is assigned to Nokia Mobile Phones Ltd. (assignment recorded at Reel 010413, Frame 0869 on December 6, 1999), which is an auxiliary trade name of the Assignee of the present application, Nokia Corporation. Further, Nokia Mobile Phones Ltd. was merged into Nokia Corporation on October 1, 2001 (as evidenced by the document included in the attached Appendix). As such, *Sivula* was assigned to the same entity as that to which the claimed invention of the present application was assigned at the time that the claimed invention was made. Given that *Sivula* is prior art to the present application, if at all, under 35 U.S.C. § 102(e), Applicant respectfully submits that 35 U.S.C. § 103(c) prohibits the utilization of *Sivula* as part of an obviousness rejection of the present application. Therefore, it is submitted that the rejection of the claims under 35 U.S.C. § 103(c) is consequently overcome.

The above notwithstanding, Applicant has filed concurrently with this Amendment an IDS citing European Patent Application No. 00307931.6 to Timo Sivula ("*Sivula II*"), which application was published as European Patent Application Publication No. EP 1091601 on

April 11, 2001. As such, Applicant below provides more substantive responses to the rejections provided in the Official Action and based on *Sivula*.

*Mackintosh* is directed to the presentation of supplemental information regarding material being broadcast. In one embodiment, a program provider, such as a radio station, provides broadcast materials, for example, by broadcasting its radio program via the Internet to a number of users' personal computers. The program provider also provides information pertaining to the broadcast materials, such as a real-time identification of the song being played. A data server utilizes the data provided by the program provider to retrieve supplemental materials related to the broadcast materials and to provide those supplemental materials to users in coordination with the broadcast materials. For example, the data server can retrieve images, video clips, or textual data relating to the song presently being broadcast. *See* col. 5, l. 7 – col. 6, l. 4. In one embodiment, users may be provided with a display populated with textual information such as the song title, the artist name, and the title of the album from which the song originates. *See* col. 22, l. 55 – col. 23, l. 6.

As discussed previously, *Sivula* provides for the adaptation of special content messages between mobile telephones of different capabilities. A special application service center receives a special content message (*e.g.*, a message containing both text and images) from an originating mobile station and, in response thereto, sends a short message (using the existing short message service) to an addressed terminating mobile station with a notification of the nature of the intended special content message. The special application service center also sends an indication of an alternative method of receiving the special content message if the terminating mobile station is not capable of processing the special content message, for instance, a URL which the user can consult using his personal computer over the Internet. If the terminating mobile station is capable of receiving the special content message, it signals the special application service center which, after authentication, then forwards the special content message to the terminating mobile station for processing. *See* Abstract.

Applicant respectfully submits that neither *Mackintosh* nor *Sivula* discloses the selection by a user of a wireless terminal whether to originally transmit from the wireless terminal a specifically-provided content-related predefined message and then originally transmitting the

selected content-related predefined message to an address selectable by the user of the wireless terminal, as recited, in one form or another, in each of the independent claims. Instead, these references disclose, respectively, the reception at a user terminal of a transmission containing supplemental information associated with broadcast materials (*i.e.*, the display provided in conjunction with a broadcast song and populated with textual information such as the song title, the artist name, etc.) and the capability of having a "special content message," under the appropriate conditions, automatically transmitted to a user terminal after a notification regarding the special content message has been provided to that user terminal. As such, neither *Mackintosh* nor *Sivula* addresses the situation where or conditions under which a message is sent from a user terminal to another device at the prompting of the user of the user terminal.

The Official Action admits (*see* p. 5 of the Official Action) that . . .

*Mackintosh does not specifically disclose the at least one wireless terminal further comprises selecting means for enabling selecting, by the user of said at least one wireless terminal, whether to transmit one or more of the provided at least one content-related predefined messages wirelessly from said at least one wireless terminal, and transmitting means for transmitting, if the user of said at least one wireless terminal selects to transmit one or more of the provided content-related predefined messages, the selected content-related message to at least one address selectable by the user of said at least one wireless terminal.*

However, the Official Action notes that *Mackintosh* includes a (potentially wireless) communications interface, and further goes on to state (*see* pp. 5-6 of the Official Action):

Additionally, Sivula discloses an analogous message content delivery system wherein a user may utilize a wireless phone comprising selecting means for enabling selecting by the user of said wireless phone whether to transmit content including a content-related message from said wireless terminal as well as transmitting means for transmitting the content and related pre-defined message to at least one address selectable by the user of said at least one wireless terminal (col. 6, lines 20-27). The ability to forward messages among cell phone users, e.g. "text messaging", is well known to one of ordinary skill in the art.

The cited passage from *Sivula* reads as follows:

"When such a service center 14 receives a special content message, such as the message on line 12 of FIG. 1 from an originating mobile station 10 having the capability to provide the special content message, it is not necessarily the case that a terminating mobile station 16 that is addressed- by the originating mobile station 10 is fully capable of processing the special application message."

While it is not entirely clear to Applicant how the above passage relates to the analysis, it may be that the Official Action seeks to generally invoke the text messaging capability of cellular telephones in combination with *Sivula* in order to demonstrate the existence of a capability to select from a wireless terminal whether to forward from the wireless terminal a previously received content-related message and then transmit the selected content-related message to an address selectable by the user of the wireless terminal. However, the independent claims of the present application are directed to the provision of a content-related, predefined message that can be selected by the user of a wireless terminal for original transmission from the wireless terminal, rather than the re-transmission of a previously received message.

For at least the above reason, Applicant respectfully submits that independent Claims 1, 11, 31, 43, and 46, as well as the claims depending therefrom, are patentable over *Mackintosh* and *Sivula* (or *Sivula II*), taken either alone or in combination.

## **II. Double-Patenting Rejections**

The Official Action rejected all of the claims based on non-statutory (obviousness type) double patenting in light of U.S. Patent Number 6,908,389 to Puskala ("the '389 patent"), which is the parent of the present application. In response, Applicant is submitting herewith a terminal disclaimer dedicating to the public the terminal part of any patent granted on the present application that would extend beyond the expiration date of the full statutory term of the '389 patent. Therefore, Applicant respectfully requests that the rejections based on non-statutory type double patenting be withdrawn, consistent with MPEP § 804.02. Applicant also notes that the filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). Additionally, Applicant's representative apologizes for the erroneous omission of this terminal disclaimer in conjunction with the previously filed Amendment.

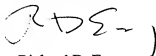
Application No.: 10/091,038  
Amendment Dated March 12, 2008  
Reply to Office Action of December 31, 2007

**CONCLUSION**

In view of the amendments and remarks presented above, Applicant respectfully submits that all of the claims in the present application are in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicant's undersigned attorney in order to resolve any remaining issues.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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**APPENDIX**

**Translation from the Finnish**

1(2)

NATIONAL BOARD OF PATENTS  
AND REGISTRATION  
Trade Register  
Arkadiankatu 6 A  
00100 Helsinki  
tel. (09) 6939 500

Page 1  
Business ID: 0300326-6  
Issued: 01.10.2001

**EXTRACT FROM THE TRADE REGISTER**

Trade name:  
Nokia Matkapuhelimet Oy (Nokia Mobile Phones Ltd.)

Business ID: 0300326-6  
Trade Register number: 269,874  
Date registered: 06.07.1979  
Company form: limited company  
Domicile: Espoo  
Content of extract: Information in register at 01.10.2001.

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Information regarding registered notification:  
Journal No. No. Entered in register Announced in Gazette  
2001/124664 54 01.10.2001 40/01

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**Register entries:**

EXECUTION OF MERGER (Registered 01.10.2001)  
with the permission of the register authority Marineland Oy  
business ID 0196242-0, Nokia Networks Oy business ID 0101120-3,  
Nokia Matkapuhelimet Oy business ID 0300326-6, Nokia Display  
Products Oy business ID 0751877-7 and Nokia Multimedia Terminals  
Oy business ID 0812093-9 have merged with Nokia Oy] business ID  
0112038-9.

DISSOLUTION (Registered 01.10.2001)  
The company has been dissolved.

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ADDITIONAL INFORMATION:  
Possible information on bankruptcy, liquidation or restructuring  
procedures is not available from the system for the period up to  
02.12.1994.  
01.10.2001 Registered as dissolved

HISTORY OF TRADE NAME:  
21.06.1989 - 30.09.2001 Nokia Matkapuhelimet Oy  
24.07.1986 - 20.06.1989 Nokia-Mobira Oy  
06.07.1979 - 23.07.1986 Mobira Oy

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Information retrieved from the Trade Register system. Printed



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Page 2  
Business ID: 0300326-6

on stationery belonging to the National Board of Patents and  
Registration the document is original without a signature.

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For a true translation  
15 April 2002

*D. Morris*

Virallinen kääntäjä  
DAVID MORRIS  
Authorized translator